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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/647,253	08/26/2003	Yasunori Ando	116942	2080

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EXAMINER

HOFFMANN, JOHN M

ART UNIT	PAPER NUMBER
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1731

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/647,253

Applicant(s)

ANDO ET AL.

Examiner

John Hoffmann

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2005.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10,11,13-15,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10,11,13-15,17 and 18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 12/27/05 has been entered.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 10-11, 13-15 and 17-18 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Examiner could find no support for the newly claimed limitation in the preamble that the material is "composed mainly of nonoxide ceramic". This is deemed to be a prima facie showing on failure to comply with the requirement. The burden is now on

Applicant to show the requirement is complied with, or to amend the claims so that they comply.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 10-11, 13-15 and 17-18 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase “composed mainly of nonoxide ceramic” is indefinite as to its meaning. Examiner could find no indication in the specification as to what is meant by this. Examiner is uncertain if it just means that the material has the ceramic, as a “main” ingredient; in which case 25% might be considered a main ingredient. Or if it means at least 50%, or something else.

Also, as indicated in MPEP 2111.03: The transitional phrase “composed of” has been interpreted in the same manner as either “consisting of” or “consisting essentially of,” depending on the facts of the particular case. See AFG Industries, Inc. v. Cardinal IG Company, 239 F.3d 1239, 1245, 57 USPQ2d 1776, 1780-81 (Fed. Cir. 2001) (based on specification and other evidence, “composed of” interpreted in same manner as “consisting essentially of”); In re Bertsch, 132 F.2d 1014, 1019-20, 56 USPQ 379, 384 (CCPA 1942) (“Composed of” interpreted in same manner as “consisting of”; however, court further remarked that “the words composed of” may under certain circumstances

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be given, in patent law, a broader meaning than consisting of.”). It is unclear how “composed mainly of” should be interpreted – as to whether it is merely “consisting essentially of” or what.

The term “predetermined” shape (claim 10, line 11 and claim 14) reads on a nebulous mental step conducted prior to the manipulative steps of the claimed process, hence rendering the present process claim unclear in meaning in scope. If applicant wishes to patent detail controls over the recited process, the process steps must be positively recited. See Seagram & Sons Inc. vs Marzall, 84 USPQ 180. When a person makes a shape, one cannot tell if the person predetermined the shape or not – unless one has a mind-reader.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Japanese publication 1-188479.

A translation should be available for fax on 10 April 2006 from examiner –please call 571-272-1191.

As indicated in MPEP 2130.03:

When the prior art discloses a range which touches, overlaps or is within the claimed range, but no specific examples falling within the claimed range are disclosed, a case by case determination must be made as to anticipation. In order to anticipate the claims, the claimed subject matter must be disclosed in the reference with "sufficient specificity to constitute an anticipation under the statute." What constitutes a "sufficient specificity" is fact dependent. If the claims are directed to a narrow range, the reference teaches a broad range, and there is evidence of unexpected results within the claimed narrow range, depending on the other facts of the case, it may be reasonable to conclude that the narrow range is not disclosed with "sufficient specificity" to constitute an anticipation of the claims. The unexpected results may also render the claims unobvious. The question of "sufficient specificity" is similar to that of "clearly envisaging" a species from a generic teaching. See MPEP § 2131.02. A 35 U.S.C. 102 /103 combination rejection is permitted if it is unclear if the reference teaches the range with "sufficient specificity." The examiner must, in this case, provide reasons for anticipation as well as a motivational statement regarding obviousness. Ex parte Lee>, < 31 USPQ2d 1105 (Bd. Pat. App. & Inter. 1993) (expanded Board). For a discussion of the obviousness of ranges see MPEP § 2144.05.

Presently: the Japanese ranges teach the invention with sufficient specificity to constitute anticipation. Applicant's 5-60 parts Si metal corresponds to 4.8%-37.5% - which is covered by half of the 10-75% disclosed by the Japanese publication. The Japanese "up to 40 micron" Si is nearly whole within the 1-50 micron range of claim 10. And the 44-149 micron range for Silicon nitride of the publication has substantial overlap with the claimed 1-50 micron range.

As to the claimed reaction sintering in an atmosphere and temperature range that allows nitriding for two-12 hours. It is deemed that whatever atmosphere and temperature is used: it has no bearing on how long one can "allow" the nitriding to proceed. In other words, the claim does not require a step of nitriding to occur for 2-12 hours, rather the claim uses very broad language that does not limit the claim in any meaningful way. Neither atmosphere, temperature nor their combination can prevent anything from occurring – thus it "allows" anything.

Claim 11: the 25-45 range is deemed to be met by the broad teaching.

Moreover, the second table on page 3 of the actual Japanese publication suggests the basis of the 10-75% that the abstract mentions: with 90% not having a useable result. Thus it appears that the 25-75 values of that table means 25% silicon and 75% nitride or 33.3 parts silicon to 100 parts nitride – this is within the claimed 25-45 range.

Claim 13: Examiner presumes that figure 1 on page 4 of the document is of molding pressure. Applicant's 30-200 MPA converts to about 306- 2039 kg/cm². The prior art figure has two values within the range: 400 and 1000.

Claim Rejections - 35 USC § 103

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the

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invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 10-11 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese publication 1-188479.

See how the reference is applied above. This rejection is made in the alternative
– in the event that the claims are not anticipated by the publication

From 2144.05 [R-1] Obviousness of Ranges:

I. OVERLAP OF RANGES

In the case where the claimed ranges "overlap or lie inside ranges disclosed by the prior

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art" a prima facie case of obviousness exists. In re Wertheim, 541 F.2d 257, 191 USPQ 90 (CCPA 1976); In re Woodruff, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990) (The prior art taught carbon monoxide concentrations of "about 1-5%" while the claim was limited to "more than 5%." The court held that "about 1-5%" allowed for concentrations slightly above 5% thus the ranges overlapped.); In re Geisler, 116 F.3d 1465, 1469-71, 43 USPQ2d 1362, 1365-66 (Fed. Cir. 1997) (Claim reciting thickness of a protective layer as falling within a range of "50 to 100 Angstroms" considered prima facie obvious in view of prior art reference teaching that "for suitable protection, the thickness of the protective layer should be not less than about 10 nm [i.e., 100 Angstroms].") The court stated that "by stating that suitable protection is provided if the protective layer is about 100 Angstroms thick, [the prior art reference] directly teaches the use of a thickness within [applicant's] claimed range."). Similarly, a prima facie case of obviousness exists where the claimed ranges and prior art ranges do not overlap but are close enough that one skilled in the art would have expected them to have the same properties. Titanium Metals Corp. of America v. Banner, 778 F.2d 775, 227 USPQ 773 (Fed. Cir. 1985) (Court held as proper a rejection of a claim directed to an alloy of "having 0.8% nickel, 0.3% molybdenum, up to 0.1% iron, balance titanium" as obvious over a reference disclosing alloys of 0.75% nickel, 0.25% molybdenum, balance titanium and 0.94% nickel, 0.31% molybdenum, balance titanium.). "[A] prior art reference that discloses a range encompassing a somewhat narrower claimed range is sufficient to establish a prima facie case of obviousness." In re Peterson, 315 F.3d 1325, 1330, 65 USPQ2d 1379, 1382-83 (Fed. Cir. 2003). However, if the reference's disclosed range is so broad as to encompass a very large number of possible distinct compositions, this might present a situation analogous to the obviousness of a species when the prior art broadly discloses a genus. Id. See also In re Baird, 16 F.3d 380, 29 USPQ2d 1550 (Fed. Cir. 1994); In re Jones, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992); MPEP § 2144.08.

The percentages of component and sizes disclosed in the English language abstract overlap with the claimed ranges and thus constitute a prima facie showing of obviousness.

It would have been obvious to perform routine experimentation to determine the optimal values for the claimed ranges including the time for nitriding.

And for claim 13: the pressure does not seem to be disclosed. It would have been obvious to perform routine experimentation to determine the optimal pressing force. Examiner takes Official notice that molding pressure is a well known result-

effective variable – for numerous effects: the pressure effects the green strength, the density, and particle-to-particle contact.

Claims 14-15 and 17-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese publication 1-188479 as applied to claims 10-11 and 13 above, and further in view of Mangels 4285895.

The Japanese publication does not teach the use of yttria. At least examples 3 and 9 of Mangels discloses that adding yttria to the starting powders when making silicon nitride articles results in stronger final products than if there is no yttria. It would have been obvious to add yttria to the Japanese process so as to increase the strength of the product. Claims 14-15 and 18 are clearly met.

Claim 17 specifies the size of the particles. The Japanese publication discloses that particle size is a result-effective variable. It would have been obvious to perform routine experimentation to determine the optimal particle size for the yttria.

Claims 17 is rejected under 35 U.S.C. 103(a) as being unpatentable over Japanese publication 1-188479 and Mangels 4285895 as discussed above, and further in view of Kingery, "Introduction to Ceramics" 2nd ed page 9.

From page 9, lines 5-10 of Kingery, particle size is one of the "most critical factors" in ceramics processing. It would have been obvious to perform routine experimentation to determine the optimal particle size for the yttria, such being a critical result-effective variable.

Response to Arguments

Applicant's arguments have been considered but are moot in view of the new ground(s) of rejection.

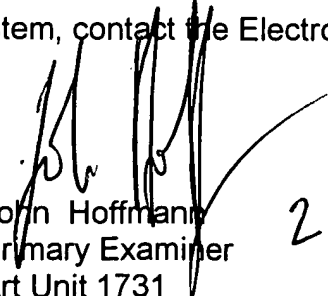
Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Both Inoue patents, Noguchi and Nicholson are cited as teaching most of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Hoffmann whose telephone number is (571) 272 1191. The examiner can normally be reached on Monday through Friday, 7:00- 3:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Steve Griffin can be reached on 571-272-1189. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


John Hoffmann
Primary Examiner
Art Unit 1731

2-13-06